

Notice of Allowability

Application No.

10/601,968

Examiner

Brian S. Kwon

Applicant(s)

FENSOME ET AL.

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Telephonic Interview on 04/09/07 and Amendment filed 09/29/06.
2. ☒ The allowed claim(s) is/are 2,3,8-10,29 and 32-35.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

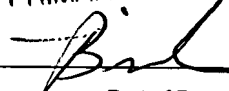
Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 20070410.
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

BRIAN-YONG S. KWON
PRIMARY EXAMINER



DETAILED ACTION

1. The restriction/election of species requirement, as set forth in the Office action mailed on 09/28/05, has been reconsidered in view of the allowability of claims to the elected invention pursuant to MPEP § 821.04(a). The restriction/election of species requirement between formula I and formula II compound(s) is hereby withdrawn as to any claim that requires all the limitations of an allowable claim. Claims 8 and 10, directed to non-elected species, are no longer withdrawn from consideration because the claim(s) requires all the limitations of an allowable claim.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Examiners Amendment

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Cathy A. Kodroff on April 09, 2007.

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The application has been amended as follows:

Amendment to the claims:

In claim 8, lines 5-6, delete [, tautomer, metabolite, or prodrug].

In claim 9, lines 3-4, delete [, tautomer, metabolite, or prodrug].

In claim 29, line 10, [, a tautomer, prodrug, metabolite,].

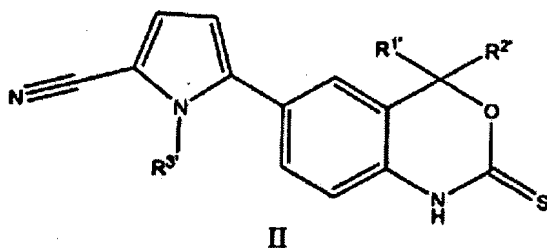
In claim 32, line 1, delete [and/].

In claim 32, line 2, add --an effective amount of-- before “a compound of formula I”.

In claim 32, delete [, tautomer, metabolite, or prodrug thereof] and replace with
-- thereof to treat said acne or hirsutism --.

Add new claims 33-35.

Claim 33. A method for treating acne or hirsutism in a mammal comprising administering to said mammal in need thereof a composition comprising an effective amount of a compound of formula II represented by the structure:



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wherein: R^{1'} is selected from the group consisting of methyl, ethyl, and trifluoromethyl; R^{2'} is selected from the group consisting of methyl, ethyl, and trifluoromethyl; or R^{1'} or R^{2'} are fused to form a spirocyclic ring containing 3 to 7 carbon atoms; and R^{3'} is C₁ to C₄ alkyl; or pharmaceutically acceptable salts thereof to treat said acne or hirsutism.

Claim 34. The method accordingly to claim 33, wherein said compound is 5-(4-ethyl-4-methyl-2-thioxo-1,4-dihydro-2H-3,1-benzoxazin-6-yl)-1-methyl-1H-pyrrole-2-carbonitrile, 5-(4,4-diethyl-2-thioxo-1,4-dihydro-2H-3,1-benzoxazin-6-yl)-1-methyl-1H-pyrrole-2-carbonitrile, 1-methyl-5-(2-thioxo-1,2-dihydrospiro[3,1-benzoxazine-4,1'-cyclobutan]-6-yl)-1H-pyrrole-2-carbonitrile, 1-methyl-5-(2-thioxo-1,2-dihydrospiro[3,1-benzoxazine-4,1'-cyclohexan]-6-yl)-1H-pyrrole-2-carbonitrile, 1-methyl-5-(2-thioxo-1,2-dihydrospiro[3,1-benzoxazine-4,1'-cyclopentan]-6-yl)-1H-pyrrole-2-carbonitrile, 1-methyl-5-[2-thioxo-4,4-bis(trifluoromethyl)-1,4-dihydro-2H-3,1-benzoxazine-6-yl)-1H-pyrrole-2-carbonitrile, or pharmaceutically acceptable salts thereof.

Claim 35. The method accordingly to claim 33, wherein said compound is 5-(4,4-dimethyl-2-thioxo-1,4-dihydro-2H-3,1-benzoxazin-6-yl)-1-methyl-1H-pyrrole-2-carbonitrile, or pharmaceutically acceptable salts thereof.

Claims 30 and 31 are cancelled.

Conclusion

3. Claims 2, 3, 8-10, 29, 32 and 33-35 are allowed.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (571) 272-0581. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, can be reached on (571) 272-0718. The fax number for this Group is (571) 273-8300.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications may be obtained from Private PAIR only. For more information about PAIR system, see <http://pair-direct.uspto.gov> Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Brian Kwon
Primary Patent Examiner
AU 1614

A handwritten signature in dark ink, appearing to be 'B. Kwon', with a long horizontal stroke extending to the right.

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